

## REMARKS

The present response is responsive to the Examiner's rejection noted in the Office Action.

### Summary of the Response

No amendments to the original claims have been presented in this response. Claim 20 has been added. Claims 1-20 are now pending in this application.

### Summary of the Rejections

Claims 1-19 have been rejected under 35 USC 103(a) as being obvious over U.S. Patent No. 4,811,382 to Sleevi. Claims 1-19 have been also been rejected under 35 USC 103(a) as being obvious over Japanese Patent Publication No. JP06-121043 to Yoshihide and Korean Patent Publication No. KR1999-46606 to LG Telecom. These rejections are respectfully traversed in view of the arguments presented below.

### Summary of the Invention

The present invention is directed to a method, device and system for generating a commercial information ringback tone such as advertisements, music or news during a communication wait, and more particularly to a method, device and system for generating voice/text/image commercial information ringback tone during the period communication is on wait. When a telephone caller initiates a call, prior to the system ringing the called party, the system starts to provide the caller with the commercial information, which the caller can hear and/or see via the caller's telephone set the various commercial information such as

advertisements, music or news, in the forms of voice, text or image instead of a ringing sound that is provided after ringing the called party. In one embodiment, the system initiates ringing of the called party only after a predetermined period from the origination of the call by the calling party. Prior art systems provide commercial information after ringing the called party while waiting for the called party to answer the call.

The cited and applied references do not teach or suggest the features of the present invention, whether taken alone or in combination.

#### 103 Rejection of Claims 1-19 Based on Sleeve

At the onset, Applicant notes that the Examiner failed to point out with particularity how the details missing in Sleeve would render the limitations of independent claims 1 and 18 obvious, and further the additional limitations of the seventeen claims dependent from claims 1 and 18. The Examiner only provided a sweeping statement that: "Sleeve does not explicitly teach details as claimed in the claims. However, those limitations lie fully under a normal capability of a person skilled in the art." But the Examiner failed to refer to any particular limitations, much less any basis of finding "normal capability", contrary to the examination practices required by the MPEP. It would be unfair to place the burden on the Applicant, to speculate the Examiner's basis of rejection, and the exact nature of the details missing in the cited references. Instead, the Examiner is obligated to provide clear and thorough basis of rejections noted in the Office Action.

Applicant specifically requests the Examiner to specifically point out the basis of rejection for each and every claim limitations under this rejection. The Examiner is requested to

review the requirements of MPEP 706.02(j) "Contents of a 35 U.S.C. 103 Rejection", and other relevant sections that obligate the Examiner to provide a clear and thorough basis of rejection in an Office Action. Specifically, MPEP 706.02(j) states in part:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

...

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections."

...

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid ( 35 U.S.C. 282) and constitute a property right ( 35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

..."

Should the Examiner maintain this rejection in this next Office Action, the Applicant should be given an opportunity to consider any basis identified by the Examiner. The next Office Action should not be made final in order to allow the Applicant a fair opportunity to respond to such basis raised for the first time.

Given that the Examiner failed to clearly recite the basis of obviousness of the missing details, however in the interest of expediting the allowance of this case, Applicant would attempt to comment on certain exemplary deficiencies of the cited references.

Claim 1 recites a method which requires the steps of “beginning to transmit a commercial information instead of the original ringback tone or the guide message to an originating side telephone from the commercial information ringback tone generating system in at least one form of a voice, a text, and/or an image during a communication wait, requesting a connection to a receiving telephone from the commercial information ringback tone generating system after a first predetermined time (A-timeout) lapses, and continuously transmitting the commercial information to the originating telephone”.

In contradistinction to the present invention defined in claim 1, Sleevei does not provide commercial information prior to the ringing of the called party, much less at a time after a predetermined time lapses. Instead Sleevei provides messages to the calling party during the ringback period of a telephone call, after a call has been placed and during which the calling party is waiting for the call to be answered. Evidence of such is clearly stated in Sleevei, at various sections. For example, referring to the Abstract in Sleevei, “[t]he messages are preferably applied between successive ringback tones during the ringback period and are terminated when the called party answers the call.” Also referring to Sleevei at column 2, lines 40 to 44: “... messages such as recorded commercial advertising messages are applied to the customer lines of

calling parties during the ringback period when the customers are waiting for a call they have placed to be answered.” Further, at column 2, lines 44 to 51: “The equipment for implementing the system is located in the switching centers and usually includes a **ringback detector** which detects the application of a ringback signal to the calling customer’s line. A timer is then activated to control the application of a recorded message to the line in a manner to assure that **messages are applied between ringback tones** and discontinued during the tones.” Given the facts that a **ringback detector** is required, the ringback tone is detected, and the messages are applied between ringback tones, it could only mean that the system had already rung the called party, hence creating a ringback tone, which would then allow the system to detect and determine the application of the messages.

Accordingly, it is abundantly clear that the messages are provided after the called party had been rung, and during the ringback period when the calling party is waiting for the called party to answer the call. The messages are terminated upon the called party answering the call.

With respect to the independent device claim 18, it requires: “a subscriber’s private information server for providing subscriber’s private information individually in terms of regions, gender, ages and time bands, the commercial information ringback tone is provided depending on the subscriber’s private information.” The Examiner did not address claims 18 with respect to this and other limitations.

The Examiner has not pointed out where in *Sleeve*, or else where, is there any suggestion that *Sleeve* should be modified in a manner required to meet the claims 1 and 18, and the limitations of the dependent claims.

Further, it is abundantly clear that *Sleeve* teaches away from ringing the called party after initiation of delivery of the commercial information, and at a predetermined time lapse after the

caller originated the call. Referring for example to the sections in Sleevei quoted above, given the preferred structure of the Sleevei system, and the preferred timing of the application of the messages after there is detected a ringback tone, the present invention of claim 1 cannot be deemed obvious in view of Sleevei.

Still further, the present invention is in a crowded art; therefore any difference, even if a small step forward should be regarded as significant as to avoid obviousness.

Applicant respectfully submits that the Examiner applied impermissible hindsight reconstruction of Sleevei, made possible only with the benefit of the present application.

Accordingly, independent claims 1 and 18, and all the claims dependent therefrom are patentable over Sleevei.

#### 103 Rejection of Claims 1-19 Based on Yoshihide and LG Telecom

As in the rejection based on Sleevei, the Examiner did not present a clear and thorough basis for this rejection. Instead, the Examiner relied on an International Preliminary Examination Report of the parent PCT patent application, by simply stating: "See International Preliminary Examination Report"<sup>1</sup>, without anything more.

At the outset, Applicant submits that by nature of a preliminary examination, it would not meet the level of examination required by a full examination before the U.S. Patent Office.

Given the brevity of the Examiner's comments concerning the rejections, the Examiner appeared

---

<sup>1</sup> At the present time, the assignee of the present application does not have the files of the counterpart PCT patent application, which was filed by the previous assignee. The present assignee only has access to the IPER in the file of the present application. Applicant can only assume that there was only a single IPER issued in the PCT application, and that the copy in the file would be the IPER that the Examiner is referring to.

to have only conducted a “preliminary examination”. Applicant is not aware of a preliminary examination process that have been adopted by the U.S. Patent Office. There is no authority in the statute, MPEP or the Rules, which would permit the Examiner herein to simply apply similar references in an IPER to conduct a preliminary examination of the present application!

Further, the IPER commented on separate and individual disclosure of the references, without stating any basis to establish the combination of the references. The IPER then stated that, with respect to claims 1-17, “Therefore, the method for generating commercial information through a communication system in claims 1-17 is extremely similar with the methods of [Yoshihide] and [LG Telecom]”; and with respect to claims 18 and 19, “Therefore the commercial information server, the commercial information ringbacktone generating system and the subscriber’s private information server in the claims 18 and 19 are already included in [Yoshihide] and [LG Telecom], and a final statement that: “From what it’s mentioned above, it can be concluded that Claims 1-19 lack an inventive step under PCT Article 33(3). The invention claimed in Claims 1-19 possesses novelty according to PCT Article 33(2) and is considered to be industrially applicable under PCT Article 33(4).” Since when did the U.S. Patent Office begin to examine U.S. patent application by relying on PCT Articles? And how is the conclusion that Claims 1-19 lack inventive step been established under PCT Article 33(3), and how that would translate to 35 USC 103(a), and further the statutory basis for such? The Examiner had not obtained a translation of the references that are in foreign language, and pointed to specific relevant sections in the references. The IPER should not be deemed the authority in the interpretation of these references.

Notwithstanding the foregoing, in the interest of forwarding this case to early allowance, Applicant provides the comments below with respect to exemplary deficiencies in the references.

Applicant conducted an online search, and obtained an abstract in English for Yoshihide.

A copy of the abstract is attached. According to the "CONSTITUTION" stated in the abstract:

"When the call originating operation is performed on a calling telephone set 3t to transmit a dial signal to a calling-side exchange station [1t], this station [1t] transmits a called telephone set discrimination signal to a called-side exchange station 1r and sends the ringing tone signal to the calling telephone set 3t. At this time, various public reports, commercial advertisements of private enterprises, or product advertisements are sent instead of the ringing tone signal."

This only English description is quite different from the comments noted in the IPER. Further, assuming this English abstract is an accurate description of the Yoshihide system, it does not teach or suggest the invention defined by claim 1. Further, referring to Fig. 5 in Yoshihide, it appears that the sub-figures (1) and (2) refer to the relationship of the actions between the various components in the system, and the sequence of actions in the disclosed process. The undersigned is by no means an expert in Japanese language, but has a very limited understanding of Japanese Katagana, which draws similarities to Chinese characters. It appears that the "S5" step in Fig. 5(1) and Fig. 5(2) represents the step of calling-side exchange station 1t transmitting a called telephone set discrimination signal to a called-side exchange station 1r, as is disclosed in the abstract. Further, it appears that the "S4" step in Fig. 5(1) represents the step of calling-side exchange station 1t sending the ringing tone signal to the calling telephone set 3t. The commercial audio signal appears to be sent in the step of "AS" by the called-side exchange station 1t. As such, it is clear from the sequence of steps that the commercial audio signal AS is not sent before the ringing of the called party, since the step of transmitting a called telephone set discrimination signal to a called-side exchange station 1r is prior to the step "AS", and further the commercial audio signal AS is not sent after a predetermined time lapse, as is required in claim 1.



LG Telecom does not make up for the deficiencies of Yoshihide. The Examiner has not pointed out, and not even the IPER has pointed out, how LG Telecom can and has made up for the missing disclosure in Yoshihide. Hence, even if LG Telecom can somehow be combined with Yoshihide, the combination would not obtain the present invention as defined by claim 1, and further all the claims dependent therefrom.

Further, Applicant respectfully submits that the cited references should not be combined in the first place to render the claimed invention, since such combination would not have been obvious to a person skilled in the art. It is clear that the cited references do not contain any suggestion (express or implied) that they can and should be combined, and in any specific manner to obtain the claimed invention. Each cited reference is complete and functional in itself, so there would be no reason to use parts or structures from, or add or substitute parts or structures to another reference. Further, the cited references take mutually exclusive paths and reach different solutions to similar or different problems that the respective documents address. They effectively teach away from each other (expressly or by implication), therefore it would not be logical to combine them. Even if the references can somehow be combined, it would be necessary to make modifications, not taught in the prior art, in order to combine the documents to obtain the claimed invention. Such modifications would only be apparent with impermissible hindsight reconstruction given the benefit of the disclosure of the claimed invention.

Since the Examiner relied on the IPER in the PCT patent application, Applicant notes for the Examiner's information that the counterpart European application matured into a European Patent No. EP1157531B1, to the extent that the Examiner may find this to be relevant to the finding of patentability of the present application, given that the references Yoshihide and LG Telecom were cited in the common parent PCT patent application.

### New Claim

New claim 20 has been added to round out the coverage of the present invention. This new claim should be patentable over the cited references, whether taken alone or in combination, for similar reasons of deficiencies noted above.

### CONCLUSION

In view of all the foregoing, Applicant submits that the claims pending in this application are patentable over the references of record and are in condition for allowance. Such action at an early date is earnestly solicited. **The Examiner is invited to call the undersigned representative to discuss any outstanding issues that may not have been adequately addressed in this response.**

Respectfully submitted,

Dated: April 11, 2005



Wen Liu  
Registration No. 32,822

LIU & LIU  
444 S. Flower Street; Suite 1750  
Los Angeles, California 90071  
Telephone: (213) 830-5743  
Facsimile: (213) 830-5741

Attachment: Patent Abstract for Yoshihide